

REMARKS

Favorable reconsideration of this application is requested in view of the following remarks. Claims 1-11 and 14-16 remain actively pending in the case. No new matter has been added. Reconsideration of the claim is respectfully requested.

In paragraph 4 on page 8 of the Office Action, claims 1-11 and 14-16 are rejected under 35 USC §103(a) as being unpatentable over Houchin et al. (US 5,983,229) in view of Parks et al. (US 5,025,396). Applicants' respectfully traverse the rejection.

With respect to claims 8, 10, 11 and 16 Houchin fails to teach or suggest at least said user granting access to at least one third party to said at least one digital image stored at said remote image server, and said third party providing new non-image information with respect to said at least one digital image using a second non-related image software application running at said remote site. Examiner states that Col. 1 lines 5-11, Col. 2, lines 63-67 and the Abstract disclose the above two elements. However, neither the paragraphs cited by Examiner nor any other paragraph discloses Applicants' above claimed element.

Parks fails to remedy the deficiencies of Houchin as Parks also fails to teach or suggest at least said user granting access to at least one third party to said at least one digital image stored at said remote image server, and said third party providing new non-image information with respect to said at least one digital image using a second non-related image software application running at said remote site. Parks merely merges an alphanumeric data stream with a digitized image file.

Therefore, Applicants respectfully submit that claims 8, 10, 11 and 16 are patentable over the cited references.

With respect to claims 8, 10, 11 and 16 Houchin fails to teach or suggest at least said third party providing new non-image information with respect to said at least one digital image in a second non-related image software application running at said remote image server. Rather, Houchin discloses a single computer 110 wherein the technique of Houchin is practiced. *See* Col. 4, lines 45-55; Fig. 5. However, Houchin does not disclose providing new non-

image information in a second non-related image software application running on a remote image server, at a remote site or on a third party computer.

Parks fails to remedy the deficiencies of Houchin as Parks also fails to teach or suggest at least said third party providing new non-image information with respect to said at least one digital image in a second non-related image software application running at said remote image server.

Therefore, Applicants respectfully submit that claims 8, 10, 11 and 16 are patentable over the cited references.

With respect to claim 1 Houchin fails to teach or suggest at least automatically updating said non-image information stored on said electronic memory device at said first storage location with respect to said new non-image information. Rather, Houchin discloses a file structure 10 (TIFF file and flash PIX) that includes a header, image data 13, non-image data 15 and extensions. In Houchin, a software application determines whether certain extensions are present and whether or not the extensions should be maintained or deleted if core elements of the file are modified. Upon modification of the core elements, Houchin's entire file structure 10 is modified. Accordingly, Houchin does not update non-image information stored on an electronic memory device as recited in Applicants' claim 1. Houchin modifies an entire file structure. *See Fig. 1.*

Parks fails to remedy the deficiencies of Houchin as Parks also fails to teach or suggest at least automatically updating said non-image information stored on said electronic memory device at said first storage location with respect to said new non-image information. Rather, Parks merely merges an alphanumeric data stream with a digitized image file.

Therefore, Applicants respectfully submit that claim 1 is patentable over the cited references.

Because claims 2-7, 14-15 and 9 depend from claims 1 and 8 respectively, and include the features recited in the independent claim, Applicants respectfully submit that claims 2-7, 9 and 14-15 are also patentably distinct over the cited reference. Nevertheless, Applicants are not conceding the correctness of the Office Action's rejection with respect to such dependent claims and reserve the right to make additional arguments if necessary.

Also, Applicants respectfully submit that the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art.

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Gordon, 733 F.2d at 902, 221 USPQ at 1127. Applicant respectfully requests that the Examiner submit an affidavit as to the Examiner's personal knowledge or submit a prior art reference suggesting the desirability of modification.

In view of the foregoing it is respectfully submitted that the claims in their present form are in condition for allowance and such action is respectfully requested.

Respectfully submitted,



Attorney for Applicant(s)
Registration No. 53,950

Thomas J. Strouse/phw
Rochester, NY 14650
Telephone: 585-588-2728
Facsimile: 585-477-4646

If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.